THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK J. EHRGOTT, CARL J. GODDARD
and GARY R. SCHULTE

Appeal No. 96-2721
Application No. 08/148,764[1]

ON BRIEF

Before KIMLIN, ELLIS and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed November 4, 1993. According to appellants, this application is a division of Application No. 07/712,169, filed June 5, 1991; which is a division of Application No. 07/473,266, filed January 31, 1990, now U.S. Patent No. 5,047,554, issued September 10, 1991; which is a continuation-in-part of Application No. 07/340,113, filed April 18, 1989, now abandoned.

This is an appeal from the final rejection of claims 2-8, 50-59, 65-69, 75-79, 86, 87, 90-108, 112 and 113, all the claims remaining in the present application. A copy of illustrative claim 112 is appended to this decision.

The examiner relies upon the following references as evidence of obviousness:

Kadin	4,569,942	Feb. 11, 1986
Young et al. (Young)	4,962,117	Oct. 9, 1990 (filed Nov. 2, 1988)

Appellants' claimed invention is directed to 3-substituted-2-oxindole derivatives of the recited formula. According to appellants, the claimed compounds find utility in treating inflammatory conditions, in eliciting an analgesic response, in treating interleukin-1 mediated disorders and immune disfunction, in inhibiting prostaglandin H_2 synthase and in inhibiting biosynthesis of interleukin-1 in a mammal.

The appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Kadin, taken alone, or in combination with Young.

Upon careful consideration of the opposing arguments presented on appeal, we agree with appellants that the prior art applied by the examiner fails to establish a prima facie

case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

We consider first the rejection of the appealed claims over Kadin taken alone. For the reasons set forth at pages 6-8 of appellants' Brief, we find that Kadin fails to support a prima facie case of obviousness for the claimed compounds. Suffice it to say that the examiner recognizes that Kadin discloses hydrogen or alkyl groups having one to three carbon atoms as the substituent corresponding to appellants' A^1, but not the claimed substituents, and we concur with appellants that the examiner's reliance on Kadin's substituent X for the equivalency of hydrogen and halogen substituents is misplaced. Kadin's teaching of equivalency of hydrogen and halogen substituents at the X position does not establish the equivalency of such substituents at Kadin's R* position.

Concerning the examiner's rejection over Kadin in view of Young, we agree with appellants that the compounds of Kadin and Young are not sufficiently similar in chemical structure to motivate one of ordinary skill in the art to modify the R* substituents of Kadin in the manner proposed by the examiner to arrive at the claimed compounds. To wit, the bonding

between the aryl group and the heterocyclic group is substantially different in the compounds of Kadin and Young (Young employs a Y substituent as a linking group between the aryl and heterocyclic groups), and the compounds of Kadin have only one non-carbon atom in the heterocyclic ring whereas the compounds of Young have two non-carbon atoms in the heterocyclic ring (X^4 of Young is defined at column 3, lines 19 et seq.).

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
JOAN ELLIS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)	

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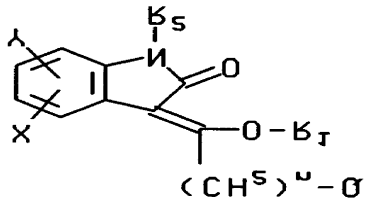
APPENDIX

112. A compound of the formula



(I)

and the pharmaceutically-acceptable salts thereof, wherein

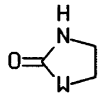
X is H, F, C1, Br, $(C_1\text{-}C_6)$alkyl, $(C_3\text{-}C_8)$cycloalkyl, NO_2, CF_3, CN, SH, $S(O)_mR^3$, OR^4, COR^4 or $CONR^4R^5$;

Y is H, F, Cl, Br, $(C_1\text{-}C_6)$alkyl, $(C_3\text{-}C_8)$cycloalkyl, NO_2, CF_3,
CN, SH, $S(O)_qR^{17}$, OR^{18}, COR^{18} or $CONR^{18}R19$;

R^1 is H, alkanoyl of two to ten carbon atoms, cycloalkyl-carbonyl of five to seven carbon atoms, phenylalkanoyl of seven to ten carbon atoms, chlorobenzoyl, methoxybenzoyl, thenoyl, omega-alkoxycarbonylalkanoyl, said alkoxy having one to three carbon atoms and said alkanoyl having three to five carbon atoms, alkoxy carbonyl of two to ten carbon atoms, phenoxycarbonyl,

1-(acyloxy)alkyl wherein acyl has one to four carbon atoms and said alkyl has two to four carbon atoms, 1-(alkoxycarbonyloxy)-alkyl wherein said alkoxy has two to five carbon atoms and said alkyl has one to four carbon atoms, alkyl of one to three carbon atoms, alkylsulfonyl of one to three carbon atoms, methylphenyl-sulfonyl or dialkylphosphonate wherein each of said alkyl is one to three carbon atoms;

R^2 is COR^6, $CONR^7R^8$, $(C_1\text{-}C_6)$alkyl, $(C_3\text{-}C_8)$cycloalkyl, phenyl or mono- or disubstituted phenyl wherein the substituent or substituents are each C1, F, Br, $(C_1\text{-}C_6)$alkyl, $(C_1\text{-}C_6)$alkoxy or CF_3;

Q is  ,  ,  ,  or  ;

A^1 is $Q^2\text{-}A^1$; CF_3, OR^9, F, Cl, Br, I, $S(O)_pR^{10}$, $COOR^{11}$, $CONR^9R^{11}$, CN, NO_2, COR^{10}, CH_2OR^{11}, $OCOR^{10}$, NR^9R^{11}, $N(R^9)COR^{11}$, $SO_2NR^9R^{11}$;

Q^2 is

m, n, p and q are each zero, one or two;

w is O, S or NR^{11};

R^3, R^6, R^{10} and R^{17} are each $(C_1\text{-}C_6)$alkyl or phenyl; R^5, R^8, R^{11} and R^{19} are each H, $(C_1\text{-}C_6)$alkyl or phenyl; and R^4, R^7, R^9 and R^{18} are each H or $(C_1\text{-}C_6)$alkyl.